

Amendments to the Drawings:

The attached sheet of drawings includes new Figs. 4-5. This sheet, which includes Figs. 4-5 is added to the specification.

Attachment: Replacement Sheet

REMARKS

The Examiner is thanked for the thorough examination of this application and the indication that claim 4 contains allowable subject matter. Claims 1 and 5 are amended herein, and claims 7, 12, and 14 are canceled.

With regard to the drawings, a new drawing sheet (which adds new FIGs. 4 and 5) is added to the application, in response to the request by the Office Action to add the fan of claims 5 and 6 to the drawings. The drawings of this sheet are very similar to the drawings of FIGs. 2 and 3, but further illustrate fans 260 and 270. These fans were described in the original specification, and therefore the addition of these drawing adds no new matter to the application.

Applicants have also amended the specification to delete the word "is," as requested by the Office Action.

Regarding independent claim 1, the Office Action rejected this claim under 35 U.S.C. § 102 as allegedly anticipated by U.S. patent 6,871,979 to Mai. For at least the following reasons, Applicants disagree.

Claim 1, as amended, recites:

1. A direct backlight module comprising:
a first plate;
a second plate connected to the first plate forming a space between;
a plurality of light sources disposed in the space; and
a third plate with a plurality of openings disposed outside the space
directly contacting the first plate.

That is, claim 1 has been amended to specify that the third plate (reflector plate 250) of the application directly contacts the first plate (diffusion plate 230). In the Mai, the third plate 52 does directly contact the first plate 50. Instead, a gap exists between the first and third plate 50

and 52. Accordingly, as amended, claim 1 is clearly not anticipated by Mai, as the structure of the claim is different from that of the Mai, and thus the rejection under 35 USC 102 should be withdrawn.

All remaining claims depend from claim 1, and therefore patently define over the cited art for at least this same reason.

In addition, and with regard to claim 3, the claimed "openings" 211 correspond to (or align with) the protrusions 251. In Mai, the opening corresponds to the recess. The structure of the application is different from that of Mai, and therefore the rejection of claim 3 should be withdrawn.

With regard to claims 5 and 6, the Office Action rejected these claims under 35 U.S.C. § 103(a) as allegedly obvious over Mai in view of U.S. patent 5,993,027 to Yamamoto. The claims define that an enforced heat dissipation device is disposed at the channel, whereby air flow produced by the enforced heat dissipation device runs along the channel (i.e., parallel to the channel). In Yamamoto, the enforced heat dissipation device is disposed outside the back light module and air flow runs perpendicularly to the channel, which has poorer heat dissipation effect than the application. For at least this reason, the rejection of claims 5 and 6 is misplaced and should be withdrawn.

As a separate and independent basis for the patentability of claims 5 and 6, Applicants respectfully submit that the Office Action has failed to cite a proper motivation or suggestion for combining the cited references. In this regard, the Office Action stated only that the combination would have been obvious "in order to better diffuse heat accumulated within the housing."

(Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a backlight module, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir.

1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int’l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

In combining Yamamoto with Mai, the Office Action said that the combination would be obvious in order to better diffuse heat accumulated within the housing. However, the Office Action doesn’t indicate why or more importantly where the suggestion is that would lead to the particular combination of features. Merely identifying some benefit (from hindsight) that results from a combination is not sufficient to justify the combination, and the motivation or suggestion

must come from the prior art itself, and the Office Action has failed to identify such a motivation. For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:



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